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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,310

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Lance R. Peterson

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BELL, BOYD & LLOYD LLP  
P.O. Box 1135  
CHICAGO, IL 60690

EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

05/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/644,310	<b>Applicant(s)</b> PETERSON ET AL.	
	<b>Examiner</b> William H. McCulloch	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/4/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to amendments received 2/4/2008. Claims 1-93 are pending in the application, with claims 1, 13, 15-16, 27-28, 40, 48, and 56 currently amended.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) with mailroom date 2/4/2008 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the Examiner has considered the information disclosure statement.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,203,430 to Walker et al. (hereinafter Walker) in view of U.S. 6,491,584 to Graham et al. (hereinafter Graham).

Regarding claims 1, 2, 28, 29, 41, 42, and 74, Walker teaches a gaming device and method comprising: a plurality of reels (see at least fig. 3B and description thereof); a plurality of symbols on the reels, said symbols including at least one first prize symbol and at least one second prize symbol (see at least figs. 3B, 4A, 8, and descriptions thereof, and 8:14-23); an initial designated number of spins of the reels, said designated number being greater than one (see at least 3:33-51); a designated number of the first

prize symbols necessary to be accumulated to win a first physical prize, wherein the designated number of first prize symbols is greater than the number of first prize symbols which can possibly be accumulated in the initial designated number of spins of the reels (symbol occurrences being limited e.g., by a number of plays; see at least 3:33-51); a designated number of the second prize symbols necessary to be accumulated to win a second different physical prize, wherein the designated number of second prize symbols is greater than the number of second prize symbols which can possibly be accumulated in the initial designated number of spins of the reels (symbol occurrences being limited e.g., by a number of plays; see at least 3:33-51); and a processor operable to control the reels, activate the reels for the initial designated number of spins, accumulate any first prize symbols which occur on the reels in each spin of the reels, accumulated any second prize symbols on which occur on the reels in each spin of the reels, award the first physical prize to the player if the accumulated number of first prize symbols reaches the designated number of first prize symbols, and award the second physically prize to the player if the accumulated number of second prize symbols reaches the designated number of second prize symbols (see at least 6:9-7:5 and 8:14-9:13).

Walker teaches the invention substantially as described above, but lacks in explicitly disclosing at least one re-trigger symbol. In a related disclosure, Graham teaches a gaming machine with a re-trigger bonus, in which predetermined events in the course of a game may initiate free or bonus games (see at least abstract, 1:29-2:26). It would have been obvious to modify the invention taught by Walker to include

the re-trigger features of Graham in order to retain and attract potential gaming customers, as is favorably taught by Graham (see at least 1:12-26).

Claims 40, 56, 61 are directed toward similar subject matter to the above claims, and additionally include a primary and secondary game, wherein at least one triggering event associated with the primary game initiates the secondary game. Walker teaches such at least by an initial game(s) ending and additional games beginning. Additionally, Graham teaches initiation of a number of bonus games upon a triggering event (see at least 1:29-2:26), which also meets the above limitation of primary and secondary games.

Claims 22, 34, 43, 48, 49, 67, 77 and 85 are directed toward similar subject matter to the above claims, and additionally include an initial designated number of free spins of the reels. Graham teaches such feature in at least 1:29-45.

Regarding claims 3, 4, and 57 Walker teaches at least one pay line associated with reels and further teaches that the processor accumulates any prize symbols that occur on any of the paylines in each spin of the reels (see at least fig. 3B, 4:45-51, 6:21-33, and claim 17).

Regarding claims 5, 7, and 30, Walker teaches that the accumulated number of prize symbols is reset when no spins remain or after a plurality of primary games (see at least 3:21-51).

Regarding claims 6 and 31, Walker teaches that the initial designated number of spins is obtained in a primary game activated upon a wager by the player (see at least 6:9-15).

Regarding claim 8, Walker teaches a prize symbol that includes an image that represents the physical prize (see at least figs. 4A and 8, and descriptions thereof).

Regarding claims 9-10, Walker teaches that the initial designated number of spins is predetermined or random (see at least figs. 9A and 9B, and descriptions thereof).

Regarding claims 11-12, Walker teaches that the designated number of prize symbols is predetermined or random (see at least fig. 8 and descriptions thereof).

Regarding claims 13 and 14, Walker teaches a plurality of different physical prizes, wherein the processor is operable to provide one of said physical prizes to the player when the accumulated number of prize symbols reaches the designated number of prize symbols necessary to win the physical prize; and further teaches that at least two of the physical prizes have different values (see at least fig. 8 and descriptions thereof).

Regarding claims 15 and 16, Walker teaches a probability of being selected by the processor associated with each of the physical prizes, wherein the processor is operable to select and provide one of the physical prizes to the player based on said probabilities (see at least 7:36-8:2).

Regarding claims 17-21 and 62, Walker teaches a prize symbol display operable to indicate the number of accumulated prize symbols (fig. 3b, element 360), further including a plurality of prize symbols indicators (fig. 3b, element 360), further including an illumination device associated with the prize symbols indicators (fig. 3A, video display 336), wherein the prize symbol display includes an integer which represents the

accumulated number of prize symbols (fig. 3b, element 360), and wherein the integer increments by at least one for each prize symbol which occurs on the reels (see at least 3:21-51 and 5:43-51).

Claims 23-26, 35-39, 44-47, 51-55, 58-60, 68-71, 78-82, and 87-91 are directed toward determining that 1) the initial number of spins, 2) prize symbols necessary to win a prize, 3) number of prize symbols, and 4) odds of obtaining a re-trigger event, is based at least in part on a wager made by the player. Each of these determinations is described at least by the citations of Walker herein because each determination must be established when the player initiates a wagering session. Teachings of Walker further dictate that the initiation is a result of the player making a wager. Therefore, Walker anticipates each of the above claims.

Regarding claims 27, 63, and 64, Walker further teaches the processor is operable to enable the player to select the physical prize from a plurality of prizes (see at least 11:61-12:14).

Regarding claims 32, 33, 50, 75, 76, 86, Walker describes a first physical prize that is of a higher value than the second physical prize, and further describes a higher probability of obtaining the second physical prize than the first physical prize (see at least fig. 8).

Regarding claims 65-66, Walker teaches awarding the physical prize to the player includes generating a prize code and further includes placing the prize code on at least one of: a receipt, a ticket, a printing medium and a recording medium (see at least 9:6-13).

Regarding claims 72, 73, 83, 84, 92, and 93, Walker teaches that the above described system and method are controller through a data network (see at least 5:1-25 and 8:24-32). The Internet is merely a group of networks. Therefore, Walker inherently teaches controlling the method and system over the Internet.

### ***Response to Arguments***

5. Applicant's arguments filed 2/4/2008 have been fully considered but they are not persuasive.

Applicant argues on page 27 of the Remarks that Walker “does not limit the number of plays in the play session (e.g., by designating a number of initial spins of the reels)” (*sic*). In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., limiting the number of plays in a play session) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Despite Applicant's assertions to the contrary, the claimed invention merely recites “an initial designated number of spins of the reels, said designated number being greater than one”, and “wherein the designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the initial designated number of spins of the reels” (see e.g., claim 1). Other independent claims contain substantially similar language. There is simply no indication in the claimed invention that the number of initial spins limits the number of plays in a play session. The number is merely a designated number of spins, which



may dictate the expiration of symbols (e.g., claim 5), in exactly the same way as is described by Walker.

Applicant acknowledges that Walker tracks a symbol that expires at a particular date and time or after a designated number of plays. Clearly, this teaching of Walker that a symbol(s) expire after a designated number of plays corresponds to the claimed feature of an initial designated number of spins.

Applicant contends on pages 27-28 that Walker does not teach or render obvious the claim limitation "wherein the designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the initial designated number of spins of the reels". This argument relies upon the assumption that Walker fails to teach an initial designated number of spins of the reels. Because the Examiner has shown above that this assumption is incorrect, the argument is unpersuasive. Moreover, there are numerous indications in Walker that more than one play of the game is required in order to win a particular physical (i.e., monetary) prize. For example, Walker Figure 3B shows a game matrix having  $3 \times 3 = 9$  total symbols per game outcome. Figure 8 shows that 75 "orange" symbols are required for a win. Clearly the player could not possibly win enough orange symbols for a respective prize in a single play. The same is true for each of the other prizes illustrated in Figure 8, requiring 50 or

100 symbols to win. Furthermore, Walker recognizes the importance of encouraging a player to play multiple games in 4:23-29:

“By determining the bonus payout based on aggregated results of multiple plays during a gaming session, casino operators can encourage slot players to increase the average duration of their sessions. Further, because the bonus payout is based on multiple plays, such a bonus increases the anticipation, entertainment and excitement of a slot player.”

In summary, the aim of Walker is to encourage players to play multiple games, and Walker accomplishes such in the same manner as that of the claimed invention.

On pages 28-29, Applicant argues that the combination of Walker and Graham teaches against features of Walker, citing teachings in Walker that a play session may be measured in time periods, independent of the number of plays. Applicant argues that because Walker teaches an embodiment of the invention that measures sessions in time periods, the re-triggering feature of Graham would be "nullified" by the expiration period of Walker. Such an argument completely ignores the teachings of Walker that play sessions may alternatively be measured in a number of plays. Clearly, in the embodiment of Walker based upon a number of plays, the re-triggering feature of Graham would be considered beneficial to one of ordinary skill in the art, as described in the grounds of rejection above.

In view of the above arguments, the grounds of rejection applied in the previous action are deemed proper.

#### ***Citation of Pertinent Prior Art***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./  
Examiner, Art Unit 3714  
4/29/2008

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714